



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,556	03/29/2000	Eileen C. Shapiro	1525C/107	6059

2101            7590            10/23/2002  
BROMBERG & SUNSTEIN LLP  
125 SUMMER STREET  
BOSTON, MA 02110-1618

EXAMINER	
STIMPAK, JOHNNA	
ART UNIT	PAPER NUMBER
3623	7
DATE MAILED: 10/23/2002	

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/538,556

Applicant(s)

SHAPIRO ET AL.

Examiner

Johnna R Stimpak

Art Unit

3623

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply****A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 29 March 2000.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 and 24 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17,22,23 and 25-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 March 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.  
SK

- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## **DETAILED ACTION**

The following is a first Office Action upon examination of application number 09/538556. Claims 1-29 are pending.

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-17, 22, 23, and 25-29, drawn to bilateral decision making for facilitating evaluation between a party and a counterparty to provide a close fit between the preferences of each potential pairing of party and counterparty, classified in class 705, subclass 10.
  - II. Claims 18-21 and 24, drawn to multilateral decisions making for facilitating evaluation between a party, a counterparty and at least one co-evaluator to provide a close fit between the preferences of each potential pairing of party and counterparty with the input of the co-evaluator, classified in class 705, subclass 10.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has a separate utility such as pairing a party and a counterparty based on the preferences of the party and the preferences of the counterparty. Invention II also has a separate utility such as pairing a party and a counterparty based on the preferences of the party, the counterparty and the co-evaluator. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Art Unit: 3623

During a telephone conversation with Mr. Keith Wood on September 10, 2002, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-17, 22, 23 and 25-29. Affirmation of this election must be made by applicant in replying to this Office Action. Claims 18-21 and 24 are withdrawn from further consideration by the examiner, as being drawn to a non-elected invention. 37 CFR 1.142(b)

*Oath/Declaration*

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It was not executed in accordance with either 37 CFR 1.66 or 1.68.  
There is no date of execution for Eileen Shapiro.

*Specification*

3. The abstract of the disclosure is objected to because the length is improper. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Art Unit: 3623

4. The disclosure is objected to because of the following informalities: Tables 4, 5 and 6 are improper. The screenshots identified as tables 4, 5 and 6 are not tables and would be proper if listed as figures. Figures are not allowed in the specification.

5. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. See page 14, line 20 of the specification. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Appropriate correction is required.

### *Claim Objections*

6. Claim 17 objected to because of the following informalities: In line 4 of claim 17, applicant recites “the preference profile of each counterparty associates... a utility value to indicate the value which the party places...”. Examiner feels there is a typographical error in the claim and believes the word “party” should be replaced with –counterparty--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 1, 3, 5-13, 16, 17, 22, 23, and 25-29** are rejected under 35 U.S.C. 102(e) as being anticipated by Puram et al, U.S. Patent No. 6,289,340 B1.

As per **claim 1**, Puram et al teaches a method for facilitating evaluation comprising: obtaining from each of the parties (employers) in the first class and storing in a first digital storage medium responses from a first set of questions eliciting revelation of preferences that can be used to estimate the closeness of such party's fit with a counterparty (candidates) in such context and obtaining from each of the counterparties in the second class and storing in a second digital storage medium responses to a second set of questions eliciting revelation of preferences that can be used to estimate the closeness of such counterparty's fit with a party in such context (column 2, lines 44-55, column 3, lines 53-56; in this reference the "employers" and "candidates" provide data regarding the skills desired or possessed and that information is stored within a storage medium), deriving from the responses of each such party a first preference profile for each such party and deriving from the responses of each such counterparty a second preference profile for each such counterparty (column 1, lines 10-13; profiles are generated and stored for candidates and positions to be filled (employer profile)), and in a separate computer process, analyzing the preference profiles of the party and counterparty to generate a list of counterparties providing a relatively close fit of such party's preferences with those of

counterparties on the list and communicating the list to such party (column 7, lines 6-9, 21-22, 65-67).

As per **claim 3**, Puram et al teaches a list ranked according to the closeness of fit (abstract; the candidates are ranked according to adjusted skills scores to yield best-fit matches).

As per **claims 5 and 6**, Puram et al teaches obtaining responses from each of the parties and counterparties is accomplished using communication over a global communication network (column 3, lines 7-8).

As per **claims 7 and 8**, Puram et al teaches obtaining responses from each of the parties and counterparties includes making web pages available providing the questions and permitting entry by such party or counterparty of responses thereto (column 3, lines 50-58, column 5, lines 60-67).

As per **claim 9**, Puram et al teaches questions eliciting revelation of a utility value which indicates the value that the party places on the level of the attribute (column 5, lines 60-65; the party (employer identifies the skills desired and indicates the priority of that skill).

As per **claim 10**, Puram et al teaches questions eliciting revelation of a utility value which indicates the value that the counterparty places on the level of the attribute (column 5, lines 36-42; the counterparty (candidate) indicates priority of preferred geographic region of employment or willingness to travel).

As per **claim 11**, Puram et al teaches analyzing the preference profile of the party in relation to the preference profiles of the counterparties using a measure of distance between a set of utility values created with respect to the first series of attributes and a set of utility values

created for the second series of attributes (column 7, lines 6-13, 21-25, 51-69; the search only returns those candidates whose skills profiles matches or exceeds the specified criteria).

As per **claim 12**, Puram et al teaches a set of questions requiring the party to rank each of a non-null set of items from among a plurality of possible ranks (column 2, lines 44-49; the employer provides data regarding the skills desired and the priority of that skill for the position).

As per **claim 13**, Puram et al teaches a set of questions requiring the counterparty to rank each of a non-null set of items from among a plurality of possible ranks (column 5, lines 36-42; the counterparty (candidate) inputs preference data, for example, the candidate inputs his or her preferred geographic location).

As per **claim 16**, Puram et al teaches the preference profile of each party associates a utility value to indicate the value which the party places on the level of the attribute (column 5, lines 60-67, column 2, lines 44-50; the party (employer) identifies the importance or priority of the skills desired as part of the preference data that is gathered and stored in the profile).

As per **claim 17**, Puram et al teaches the preference profile of each counterparty associates a utility value to indicate the value which the counterparty places on each level of the attribute (column 5, lines 35-42, column 2, lines 50-55; the counterparty (candidate) indicates preference values for each attribute which are stored in the profile)

As per **claim 22**, the same rejection as applied to claim 1 above is applied to claim 22. Claim 22 is the computer process for implementing the steps of claim 1.

As per **claim 23**, the same rejection as applied to claim 1 above is applied to claim 23. Claim 23 is a question and response module for obtaining the information claimed in claim 1.

Puram et al teaches separate interfaces for collecting the profile information (column 3, lines 20-25), and also teaches storing the information in separate storage media (column 2, lines 44-55).

As per **claim 25**, the same rejection as applied to claim 1 above is applied to claim 25. In claim 25, the database is structured for storing the information obtained in claim 1. Puram et al teaches separate databases for the profile information gathered from the party (employer) and the counterparty (candidate).

As per **claim 26**, the same rejection as applied to claim 16 above is applied to claim 26. In claim 26, the information obtained in claim 16 is stored in the database of claim 25.

As per **claim 27**, the same rejection as applied to claim 17 above is applied to claim 27. In claim 27, the information obtained in claim 17 is stored in the database of claim 25.  
As per **claim 28**, the same rejection as applied to claim 11 above is applied to claim 28.  
As per **claim 29**, the same rejection is applied to claims 1 and 23 above as applied to claim 29. In claim 29, the database is structured for storing the information obtained in claim 1 by the question and response module in claim 23.

### *Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2, 4, 14 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Puram et al, U.S. Patent No. 6,289,340 B1 and CareerMosaic. The following rejections are

based on CareerMosaic.com. Applicant is reminded that the following rejections are based on the product of CareerMosaic.com

CareerMosaic.com web pages 1-16 were retrieved from the “Wayback Machine” ([web.archive.org](http://web.archive.org)). The CareerMosaic.com web pages referenced were archived on April 12, 1997.

As per **claim 2**, Puram et al teaches communicating, to a party (employer), a list of counterparties (candidates) whose preference profiles closely fit with those of the parties but does not teach communicating, to a counterparty, a list of parties whose preferences profiles closely fit with those of the counterparties. CareerMosaic.com offers a way for counterparties to receive a list of parties with whom their preferences match (pg 5 – a description of the CareerMosaic J.O.B.S. database, where the counterparty enters criteria important to the job search and the a list of companies (parties) that match are returned. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Puram et al to include the list presented to the counterparty as well. The motivation for doing so would be so that both the employer and candidate could make a more informed decision. For example if the counterparty was not presented with a list of matching parties, he or she may be inclined to take the first offer for a job. Whereas, if the counterparty knew of the parties who might be contacting them, they could make a better decision on whether to take their first offer.

As per **claim 4**, Puram et al teaches a list ranked according to the closeness of fit (abstract; the candidates are ranked according to adjusted skills scores to yield best-fit matches). Puram et al does not teach a ranked list of parties. It is old and well known in the art to rank lists to group more relevant results together. It would have been obvious to one of ordinary skill in

the art at the time of the invention to generate a ranked list of matching parties as well, so both the employers and candidates could make a well-informed decision on filling and selecting a position. A real world example would be that a candidate who receives more than one offer for employment and/or interview would choose the potential employer that best appeals to the candidate. It is for this reason one would be motivated to generate a ranked list of matching parties.

As per **claim 14**, Puram et al teaches all the limitations of claim 14, as applied to claim 9 above, but does not teach the questions revealing values without explicitly asking for the values. Puram et al teaches the party assigning a desired skill level for skills such as operating systems, languages, project experience, etc. (column 6, lines 11-14). By assigning a desired skill level to those skills, it would be obvious to one of ordinary skill in the art at the time of the invention to imply that one without those skills (or one with other skills) are not needed for the position. The motivation of using this type of question is to help the counterparty to realize what type of person is being sought after for the job. If the counterparty does not have the skills given the most priority, they would know they are not qualified.

As per **claim 15**, Puram et al teaches all the limitations of claim 15, as applied to claim 10 above, but does not teach the questions revealing values without explicitly asking for the values. Puram et al teaches the counterparty identifying their geographic location preference (column 5, lines 35-42). It would be obvious to one of ordinary skill in the art at the time of the invention to imply from that question whether or not the counterparty is willing to relocate. For example, if the candidate was living in one state and their geographic preference was in another state, the party could imply that the counterparty is willing to relocate. The motivation of using

this type of question is to help the party to find a counterparty to is available for a position in a certain geographic region and if that counterparty is willing to relocate from their current location. If the position is in a state that the counterparty is not willing to relocate to, the party would not contact that counterparty.

*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Durand et al, U.S. Patent No. 6,272,467 B1 discloses a system for data collection and matching compatible profiles.

Art Unit: 3623

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Johnna Stimpak** whose telephone number is **703-305-4566**. The examiner can normally be reached Monday through Friday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Tariq Hafiz**, can be reached on **703-305-9643**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Or faxed to:

703-305-7687	[Official communications; including After Final communications labeled “Box AF”]
703-746-3956	[Informal/Draft communications, labeled “PROPOSED” or “DRAFT”]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> Floor.

Js

Oct 16, 2002

  
TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600